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10/595,488	05/08/2006	Yasuhiro Hidaka	3712174-00548	1355
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EXAMINER				
RUST, ERIC A				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary

Application No.

10/595,488

Applicant(s)

HIDAKA, YASUHIRO

Examiner

ERIC A. RUST

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Miscellaneous

Applicant requests that the Examiner consider (a) Photoshop 6.0 Technical bible, Softbank Publishing Inc., 1st edition, 25 January, 2001, pp. 67- 68; (b) Totte Karaga Shobul" no Digital Camera Katsuyo technique," Nikkei Zero-One, N1KKEI HOME PUBLISHING, INC., No. 52, 01 September, 2000, pp. 44-57; and (c) "Digital Camera Gazo o Online Print," Nikkei Personal Computing, Nikkei Business Publications, Inc., No. 409, 13 May, 2002, pp. 98-105. See Amendment, pgs. 8-10.

Specifically, in the Amendment, on pgs. 8-10, Applicant puts forth arguments as to why the above referenced non-patent literature should be considered.

The Examiner has considered the arguments carefully, and agrees with Applicant's arguments.

Accordingly, Applicant is advised to file an IDS citing the above referenced non-patent literature. At that time the Examiner will consider the references.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2001/0053247 A1 to Sowinski et al. (hereinafter, Sowinski) in view of U.S. Patent No. 7,236,960 B2 to Manico et al. (hereinafter, Manico).

In regard to claims 37, 41, and 45, Sowinski discloses a print-ordering system comprising: a user terminal having a display device (**Sowinski, Fig. 5 for user terminal, Fig. 5, item 509 for display device**); a server having an image database (**Sowinski, Fig. 6, and [0127], image database is inherent since sample images are being used**); a print system; at least one processor (**Sowinski, Fig. 5, item 505 and/or 510**); at least one memory device (**Sowinski, Fig. 5, item 511**) storing a plurality of instructions which when executed by the at least one processor, cause the at least one processor to operate with the user terminal (**Sowinski, [0152]**), the server and the print system to:

(a) enable a user to select:

(i) a predetermined sample image stored in the image database (**Sowinski, [0127]**);

(b) in response to the predetermined sample image being selected:

(i) cause the server to generate a plurality of first image-processing-mode-selection images based on said predetermined sample image, each of said first image-processing-mode-selection images being subjected to different image processes (**Sowinski, Fig. 10, item 1004, and [0127]**);

(ii) cause the display device to display each of said generated first image processing-mode-selection images (**Sowinski, Fig. 10, item 104, and [0127]**);

(iii) enable the user to select one of the displayed first image-processing-mode-selection images (**Sowinski, Fig. 10, item 104, and [0127]**);

(iv) in response to one of the displayed image-processing-mode-selection images being selected, cause the server to store a first image processing mode based on said selected first image-processing-mode-selection image (**Sowinski, Fig. 10, item 104, and [0127]**); and

(v) cause the printer system to execute print processing based on the first image processing mode stored by said server (**Sowinski, Fig. 10, item 104, and [0127], and [0140], based on first, second, and third image processing mode, this, of course, includes first image processing mode**).

It does not appear that Sowinski discloses enabling a user to select an image stored in the user terminal; and in response to the image stored in the user terminal being selected:

(i) transmitting the image stored in the user terminal to the server;

(ii) causing the server to generate a plurality of second image-processing-mode-selection images based on said transmitted image, each of said second image-processing-mode-selection images being subjected to different image processes;

(iii) causing the display device to display each of said generated second image-processing-mode-selection images;

(iv) enabling the user to select one of the displayed second image-processing-mode-selection images;

(v) in response to one of the displayed second image-processing-mode-selection images being selected, cause the server to store a second image processing mode based on said selection of the displayed second image- processing-mode-selection image; and

(vi) causing the printer system to execute print processing based on the second image processing mode stored by said server.

The Examiner notes, however, that the only difference between claim 37 and Sowinski is that claim 37 allows a user to select his own image on the client device and then use that image for the processing that would be done on the sample image as disclosed in Sowinski.

Taking this into consideration, Manico discloses using an image provided by a user for presentation processing (**Manico, Abstract**).

It would have been obvious to one of ordinary skill in the art at the time of the invention use the teachings of Manico for using a users own image for processing presentation with the teachings of Sowinski in order to increase the amount of images available to a user. This would increase user satisfaction.

The combination of Manico and Sowinski would result in the limitations of claim 37.

In regard to claims 38, 42, and 46, which depend from claims 37, 41, and 45, respectively, the combination of Sowinski and Manico disclose wherein when execute by the at least one processor, the instructions cause the processor to operate with the user terminal and the server to, for at least one of the first image processing mode and the second image processing mode, transmit, to the User terminal, at least two image-processing-mode-selection images obtained by performing a multilevel-image processing (**Sowinski, Fig. 10, item 104, and [0127], and Manico, Abstract**).

In regard to claims 39, 43, and 47, which depend from claims 37, 41, and 45, respectively, the combination of Sowinski and Manico disclose wherein when execute by the at least one processor, the instructions cause the processor to operate with the user to terminal to:

- (a) enable the user to select a type of image processing mode (**Sowinski, Fig. 10, item 104, and [0127]**); and
- (b) determine the first or the second image processing mode based on said selected type (**Sowinski, Fig. 10, item 104, and [0127], and Manico, Abstract**).

In regard to claims 40, 44, and 48, which depend from claims 37, 41, and 45, respectively, Sowinski discloses the first image processing mode and the second image processing mode include outline emphasis, hue, color density, gradation or contrast (**Sowinski, [0126], lines 3-12, hue**).

Response to Arguments

3. Applicants' arguments with respect to claims 37-48 have been carefully considered but are not persuasive.

In regard to rejection of claims 37-48, Applicant first argues that the Sowinski fails to teach that the user selects a predetermined image, or an image from the user terminal, as recited in independent Claim 37. *See* Amendment, pg. 11.

The Examiner has considered these arguments carefully, but they are not persuasive to overcome the rejections.

First, Manico was used to disclose using an image provided by a user for presentation processing. *See* Manico, Abstract.

Second, the Examiner believes Sowinski discloses that the user selects a predetermined image. *See* for example, Sowinski, Fig. 4A, left column, "My Pictures," and [0054], where Sowinski discloses the processing is done to a customers image. Accordingly, the user would have to select an image for processing.

Applicant next argues that the image that Sowinski selects is not a sample image, but is an image owned by Sowinski. *See* Amendment, pg. 11.

While it may be true that Sowinski selects one of his previous images, this image is a sample image that has been stored, as the claims require. *See*, for example, Sowinski, [0040], [0054], and [0135]. Moreover, Applicant's claims do not require that the sample image be an image that is not owned by a user.

Accordingly, Applicant's arguments are not persuasive.

Conclusion

4. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC A. RUST whose telephone number is (571)-270-3380. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Benny Tieu can be reached on (571)-272-7490. The fax phone number for the organization where this application or proceeding is assigned is 571-270-4380.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/ERIC A. RUST/

Examiner, Art Unit 2625

10/15/2010

/Benny Q Tieu/

Supervisory Patent Examiner, Art Unit 2625